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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/788,980	02/26/2004	Jon A. Warner	CRV 302A	5457

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EXAMINER	
MILLER, BENA B	

ART UNIT	PAPER NUMBER
3725	

DATE MAILED: 08/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/788,980	WARNER, JON A.	
	Examiner	Art Unit	
	Bena Miller	3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-20 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-20 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Bena B. Miller

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-10 and 12 are finally rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Regarding claims 1 and 12, the subject matter "a non-motive toy", as now amended, is not supported by the original specification and therefore, now constitutes New Matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10 and 12 are finally rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1 and 12, it is not clear whether the claimed device is non-motive toy.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7 and 11-17 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Presnell (US Patent 2,826,001).

The device of Presnell reads on the limitations of the claimed device including a hydrodynamic body including a nose section, tail section and mid-section extending therebetween (fig.1), an internal cavity (54), at least one opening (24), a trajectory stabilizing structure including one or more drag-producing surfaces which includes at least a pair of radially spaced apart drag-producing surfaces (14), at least one non-radial fin (fig.1) and a plurality of fins (12) having a different shape (Note, in figure 1, the lower fin has two openings 22 and the upper does not include any openings therefore the shape of the fins are different). The Examiner takes the position that the toy of Presnell has a specific gravity in a range of 0.7 and 1.3, more specifically a specific gravity of 1. As noted in col. 5, par. 2, the rearward movement of the ball shift the center of gravity of the hull gives a slight rise angle and owing to the slight rise angle, the stern planes 14 produce a planning action having a forwardly directed from component during upward movement. Therefore, the Examiner takes the position that the combination of ball 56 and stern planes 14, i.e., one of the drag-producing surfaces of the trajectory stabilizing structure, will impart a non-linear movement.

Claims 1-6 and 11-16 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Farris et al (US Patent 3,157,145).

The device of Farris et al reads on the limitations of the claimed device including a hydrodynamic body including a nose section, tail section and mid-section extending therebetween (fig.3), an internal cavity (col. 2, lines 43-45), at least one opening (24), a trajectory stabilizing structure including one or more drag-producing surfaces which includes at least a pair of radially spaced apart drag-producing surfaces (48,50) and at least one non-radial fin (52). Shown in Figure 1 of Farris is a non-linear steering movement of the toy. The Examiner takes the position that the toy of Farris has a specific gravity in a range of 0.7 and 1.3, more specifically a specific gravity of 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 3, 4, 9-10, 13, 14 and 18-20 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Presnell.

Regarding claims 3, 4, 13 and 14, in the event the Applicant disagrees with the above rejection, it would have been obvious to make the device of Presnell a specific gravity in the range 0.7 and 1.3 and greater than or equal to 1 for the purpose of providing a smoother, varying trajectory path when inserted underwater.

Presnell teaches most of the elements of the claimed elements except for the trajectory stabilizing structure including at least one adjustable portion, at least one

portion that is adapted to be selectively removed from the stabilizing structure and reattached thereto and at least one portion that is selectively repositionable relative to the body. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include at least one adjustable portion for the trajectory stabilizing structure, since it has been held that the provision of adjustability, where needed, involves only routine skill in the art. In re Stevens, 101 USPQ 284 (CCPA 1954).

Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include at least one portion that is adapted to be selectively removed from the stabilizing structure and reattached thereto and at least one portion of the stabilizing structure that is selectively repositionable relative to the body, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. Nerwin v. Erlicnman, 168 USPQ 177, 179.

Claims 3, 4, 13 and 14 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Farris et al.

Regarding claims 3, 4, 13 and 14, in the event the Applicant disagrees with the above rejection, it would have been obvious to make the device of a specific gravity in the range 0.7 and 1.3 and greater than or equal to 1 for the purpose of providing a smoother, varying trajectory path when inserted underwater.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bena Miller whose telephone number is 571.272.4427. The examiner can normally be reached on Monday-Friday.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Bena Miller
Primary Examiner
Art Unit 3725

bbm
August 22, 2006